

SPECIFICATION

The Examiner indicated that the amendment filed on April 10, 2000, is objected to under 35 U.S.C. §132 because it introduces new matter into the disclosure.

Applicant respectfully submits that the amendment to page 4, line 24 to correct the typographical error in formula (I) is not new matter. As indicated in the Preliminary Amendment, formula (I) is properly recited in the original specification on page 23, line 3. Formula (I) is also properly recited in the French priority document on page 15, lines 20-21. Moreover, the correction of this typographical error is appropriate since the error on page 4 and its correction are apparent to one of ordinary skill in the art from the remaining text of the specification. In particular, formula (I) is described as comprising dicarboxylate units. See, e.g., page 4, line 23 and page 23, line 2. Based on this description, it would have been apparent to one of ordinary skill in the art that the formula (I) recited on page 23, line 3 was correct and that the formula (I) recited on page 4, line 24 contained an error, i.e., was missing the O in the parenthetical. The correction inserting the O in the parenthetical would also have been apparent to one of ordinary skill in the art.

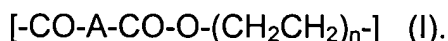
With regard to the amendment to page 5, line 22, one of ordinary skill in the art would understand that formula (I') is meant to be a derivation of formula (I). As discussed above, formula (I) was properly recited in the original specification on page 23, line 3 and was properly recited in the French priority document on page 15, lines 20-21. Based on formula (I), it would be apparent to one of ordinary skill in the art that formula (I') recited on page 5, line 22, also contained the same error that was present in formula (I) recited on page 4, line 24. However, one of ordinary skill in the art reading the complete specification, including the description of formula (I) as containing

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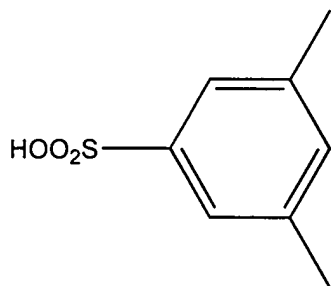
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dicarboxylate units and seeing the correct formula (I) recited on page 23, line 3, would understand that formula (I') should also include the O in the parenthetical and would understand how to correct the error. Thus, the amendment to page 5, line 22, does not introduce new matter into the claims, but merely corrects a typographical error that would be apparent to one of ordinary skill in the art and the correction of which is supported by the originally filed specification.

With regard to the amendment of "sodium dimethyl sulphonate" to --sodium dimethyl isophthalate-5 sulphonate--, Applicant respectfully submits that the correction of this error is also supported by the originally filed specification. The present invention relates to terephthalic copolyester oligomers comprising repeating dicarboxylate units of formula (I):



In formula (I), A can be a 1,4-phenylene, sulpho 1,3-phenylene, or 1,3-phenylene. For purposes of the enablement rejection, we are concerned with what happens when A is sulpho 1,3-phenylene:



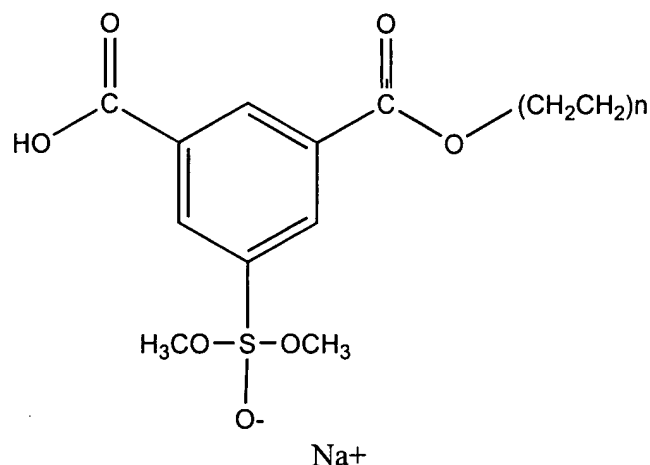
A can be sulpho 1,3-phenylene, i.e., resulting in a unit of formula (I) designated as a sulphoisophthalic monomer (see specification at page 4, line 20 to page 5, line 6).

As drawn above, the sulpho group is in the 5-position of the 1,3 phenylene ring.

Although the 5-position is not specified for the definition of A, Applicant refers the Examiner to the specification, page 9, lines 3-5, where a sulphisophthalic monomer is named as sodium dimethyl 5-oxysulphonylisophthalate. Applicant also refers the Examiner to the French priority document for this application, French Patent Appln No. 97-03118, wherein on page 14, Example 1 listed as the sulphisophthalic monomer (ingredient #2) is sodium dimethyl 5-sulphonate ("diméthyl-5 sulfonate de sodium").

Accordingly, Applicant submits that the "5" in the names of the sulphisophthalic monomer and in the Examples of the priority document support the positioning of the sulpho group of sulpho 1,3-phenylene at the 5-position of the ring. Moreover, one of ordinary skill in the art would have understood the error and Applicant's correction thereof. Applicant has amended the specification accordingly.

Now that it has been established that A can be 5-sulpho 1,3 phenylene, Applicant draws the Examiner's attention to the preferred sulphisophthalic monomer of page 9: sodium dimethyl 5-oxysulphonylisophthalate:



If one looks at this compound, it is clear that the substituent on the isophthalate ring is in fact sodium dimethyl sulphonate. This accounts for the statement on page 3,

lines 14-18, which states that A can be a sodium sulphonate. When this passage is read in light of the rest of the specification, particularly page 6, lines 2-10, and the priority document, it is clear that A is in fact a sodium sulphonate, but it could also be termed a sodium sulphonyl isophthalate.

In light of the above, it is clear that the error and correction thereof on page 21, line 12, would have been apparent to one of ordinary skill in the art and thus its correction is appropriate. Correction of this error does not amount to new matter.

Applicant has added an Abstract of the Disclosure.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the objection to the specification.

DOUBLE PATENTING

Claims 1-29, 32-36, and 39 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-23 of U.S. Patent No. 6,031,043 to Dupuis.¹ Applicant respectfully requests that this rejection be held in abeyance pending the finding of allowable subject matter.

REJECTIONS UNDER 35 U.S.C. §112

A. Claims 23-34 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time

¹ Applicant notes that claims 1-17 are not pending in this application. For purposes of responding to this rejection, Applicant will assume the Examiner rejected claims 18-29, 32-36, and 39 under the judicially created doctrine of obviousness-type double patenting.

the application was filed, had possession of the claimed invention. In particular, the Examiner indicated that the claimed hydrophilic gelling polymer of claim 23 is new matter and not supported by the foreign priority document. Applicant respectfully traverses the rejection.

Claim 23 is directed to a hydrophilic gelling polymer chosen from at least one water-soluble and water dispersible terephthalic copolyester oligomer comprising dicarboxylate repeating units of formula (I). Support for claim 23, in particular formula (I), can be found in the originally filed specification on page 23, lines 2-4. Additionally, support for formula (I) can be found in the French priority document on page 15, lines 20-21. One of ordinary skill in the art reading the originally filed specification, as well as the priority document, would believe that the Applicant had possession of the claimed invention at the time the application was filed.

In view of the foregoing remarks, claim 23 does not recite new matter. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claims 29, 31, 38, 46, 47, and 49 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for reciting improper Markush language. Applicant respectfully traverses the rejection.

The phrase "X chosen from A, B, and C" is proper language and more accurately describes the claimed invention, i.e., the composition may contain one or more X with each X independently chosen from the group A, B, and C. For example, Applicant's claim language covers a composition of the invention that may contain: A; A and B; or two A's, two B's and a C, as well as all other permutations. Applicant's claim language

See pg. 1

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is clearer, and the Office has shown no legal basis for requiring the Applicant to change it.

The Office relies on M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. However, Section 2173.05(h) merely recites examples of proper claim language which may be representative but are not exclusive. In fact, the U.S. Patent and Trademark Office (PTO) has provided other representative examples of proper alternative claim language.

Specifically, Applicant directs the Office to another example of proper alternative claim language set forth in the M.P.E.P.: "wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)." See M.P.E.P. Appendix AI (PCT), Example 20, p. AI-44 of the July 1998 edition.

In light of the additional examples of proper alternative claim language provided by the PTO, it is clear that there is no reason for the Office to require the Applicant to change the claim language of the pending claims. Accordingly, Applicant respectfully submits that this rejection under 35 U.S.C. § 112, second paragraph, is in error, and requests that the rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §102(e)

Claims 1-29, 35, 36, and 39 are rejected under 35 U.S.C. §102(e) over Dupuis et al. (U.S. Patent No. 6,031,043).² Applicant respectfully traverses the rejection.

² Applicant notes that claims 1-17 are not pending in this application. For purposes of responding to this rejection, Applicant will assume the Examiner rejected claims 18-29, 35, 36, and 39 under 35 U.S.C. §102(e) over Dupuis et al.

In order to anticipate a claim, a reference must contain all elements of the claim. See *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Further, a single source must disclose all of the claimed elements "arranged as in the claim." See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The law requires identity between the claimed invention and the prior art disclosure. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983).

The Examiner stated that the hydrophilic gelling agent disclosed in Dupuis is "a water-dispersible terephthalic copolyester oligomer comprising repeating dicarboxylate units of formula (I), which meets claims 1[8]-23." (Office Action at 4.) However, Dupuis does not teach a topical composition comprising an aqueous gel having rheological properties comprising a difference of C_2-C_1 is less than or equal to 100 Pa, as presently claimed. For at least this reason, Dupuis does not anticipate the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 18-45 and 48-53 have been rejected under 35 U.S.C. §103(a) over O'Neill (U.S. Patent No. 4,300,580) in view of Disselbeck et al. (U.S. Patent No. 5,804,025) further in view of Adams et al. (WO 95/00105). Claims 46 and 47 have been rejected under 35 U.S.C. §103(a) over O'Neill, Disselbeck, and Adams as applied to claims 18-45 and 48-53 above, and further in view of Dupuis (U.S. Patent No. 5,830,438). Since these rejections are similar, they will be discussed together. Applicant respectfully traverses both rejections.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143 (7th ed. 1998). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). As the Federal Circuit has stated, the Office must demonstrate a teaching or motivation to combine the prior art references to overcome the "powerful attraction of a hindsight-based obviousness analysis." *Id.*

O'Neill teaches a composition comprising a linear polyester derived from (a) at least one dicarboxylic acid, (b) at least one diol, and (c) a difunctional monomer. (Abstract). The composition will have an inherent viscosity (I.V.) of at least 0.15. (Col. 4, lines 19-20.) O'Neill does not teach or suggest a composition comprising an aqueous gel comprising an initial viscosity V_0 ranging from 3000 to 50,000 Pa.s, wherein said initial viscosity is stable up to a shear strain C_1 . Moreover, O'Neill does not teach or suggest a composition comprising an aqueous gel comprising a viscosity V_2 after shear at a strain C_2 , wherein a ratio of V_0/V_2 is greater than or equal to 1000. Further, O'Neill

does not teach or suggest a composition comprising an aqueous gel comprising a
difference of $C_2 - C_1$ is less than or equal to 100 Pa.

Disselbeck and Adams do not overcome the deficiencies of O'Neill. In particular, Disselbeck teaches a process wherein selected polyesters are melted incipiently or completely by high frequency welding. (Col. 1, lines 7-9.) Adams teaches a hair spray formulation comprising (1) a sulfonate-containing, water dispersible or water-dissipatable, linear polyester and (2) a liquid vehicle. (Abstract.) However, neither of these references teach or suggest the elements of independent claim 18.

The Examiner stated that it would have been obvious to modify the polyester of O'Neill by substituting the mole percents of the 1,4-phenylene and 1,3 phenylene groups of Disselbeck into the polyester, because of the expectation of achieving a specific intrinsic viscosity as disclosed by Disselbeck. (Office Action at 6) However, Disselbeck is not related to cosmetic compositions, let alone cosmetic compositions comprising aqueous gels. The Examiner stated that "[a]ll recited ingredients are well known in the hair fixative art." (Office Action at 6.) However, the Examiner has relied on Disselbeck for mole percents of polyesters when Disselbeck is directed to melting shaped structures, especially sheets, films, coats, hollow articles, injection-molded articles, yarns and textile sheet materials comprising yarns. (Abstract.) Thus, one of ordinary skill in the "hair fixative" art would not even be reading Disselbeck to solve a problem associated with the "hair fixative" art. Further, one of ordinary skill in the "hair fixative" art would have no reasonable expectation that the disclosed mole percents for modified polyesters would achieve the claimed composition having the claimed rheological-properties.

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The Examiner also argued that it would have been obvious to one of ordinary skill in the art to modify the composition of the combined references by adding the propellant of Adams because it would have been obvious to look to the prior art for how to make a hairspray. (Office Action at 6.) As discussed above, the combination of O'Neill and Disselbeck does not result in the claimed composition having the claimed rheological properties. The teaching of a propellant by Adams does not remedy the deficiencies of O'Neill and Disselbeck.

Finally, the Examiner relied on Dupuis (5,830,438) for teaching propellants for aerosol containers and argued that it would have been obvious to "have modified the composition of the combined references by substituting the propellants of Dupuis." (Office Action at 7.) However, Dupuis does not remedy the deficiencies of O'Neill, Disselbeck, and Adams.

For at least the foregoing reasons, the cited references would not have rendered obvious the claimed invention. Reconsideration and withdrawal of the rejections are respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 31, 2001

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